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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,959	07/30/1999	KEN HAYWARD	690-008568-U	1141

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER...
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2622

DATE MAILED: 03/14/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/364,959

Applicant(s)
Hayward et al

Examiner
Madeleine AV Nguyen

Art Unit
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotte (US Patent No. 5,499,108).

Concerning claim 1, Cotte discloses an electronic assembly (Figs. 12, 14) comprising an image transfer device (214) for reading and transferring an image from a first medium (216), the image transfer device including a reader (CCD) for reading the image on the first medium 216, and a display (250) for displaying an image transfer menu for effecting transfer of the image; and a computer (210) removably connected to the image transfer device; wherein when the image transfer device is inactive or not in used, a first type of menu is displayed on the display device, and when the image transfer device is active (the detection of the insertion of the document), a second type display menu is available for display on the display device.

Cotte does not specifically teach the case of the image transfer device 214 is connected or not connected to the computer 210. However, Cotte teaches the case when the transfer device

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214 connected to the computer 210 upon detecting the insertion of paper or document to be scanned and transferred the scanned document to the computer while a display menu (Fig.17) is display on the display screen; and the case when the transfer device 214 is inactive, the display 250 display a regular menu for the computer 210. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider Cotte teaches 2 different display menu in 2 different cases when the transfer device is connected to the computer or not, since the displayed menu in Fig.17 is different from the display menu of the computer since it contains the scanned document and other instructions for the user to select a menu option for the scanned document.

Concerning claims 2-3, Cotte further teaches that the image transfer device is at least one of a copier, a fax machine or a printer (Figs.10, 11A); and it includes a processor (352, Fig.11A), for controlling operation of the device, a memory (132), a user interface (134).

Concerning claims 4-13, Cotte further teaches that the second types of the image transfer menu is stored in the memory of the transfer device, the computer has software for enabling the display means to display the first or second type of menu wherein at least a portion of the second type of the image transfer menu is stored in the computer and the second type menu includes expanded features for operating the image transfer device; the first type of the menu includes a base set of different features which is commonly known for computer operations; the image transfer device is a fax machine and the extra feature is at least one of an extended phone log selection feature or adding a logo, a message or watermark; the image transfer device is adapted

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to transfer the image to a local/remote devices or printing device for printing the image; the computer is adapted for sending a polling signal (Figs. 10-18, 21-28; Abstract; col. 5, lines 45-58; col. 6, lines 19-29; col. 11, lines 24 - col. 12, line 66; col. 13, line 8 - col. 14, line 36; col. 15, lines 57-64; col. 16, lines 10-22; col. 16, line 52 - col. 17, line 10; col. 18, lines 35-57; col. 19, lines 14-35).

Concerning claims 14-18, Cotte discloses the subject matters as discussed in claims 1-13 above.

Claims 19-26 are method claims of apparatus claims 1-13. Claims 19-26 are rejected as claims 1-13.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Samuels (US Patent No. 5,270,821) discloses a video display adjustment and on-screen menu system.

b. Motoyama (US Patent No. 5,412,779) teaches a method and apparatus for controlling and communicating with business office devices.

c. Nakamura et al (US Patent No. 5,608,546) recites a data communications apparatus having a computer modem function.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine Anh-Vinh Nguyen whose telephone number is (703) 305-4860.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 308-9051 (for formal communication at s intended for entry)

(703) 308-9051 (for informal or draft communications, such as proposed amendments to be discussed an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA.
Sixth Floor (Receptionist)



Madeleine Anh-Vinh Nguyen
Primary Examiner
Art Unit 2722
March 11, 2002